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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/202,096 02/01/99 HADDLETON

D 102290

EXAMINER

IM62/0324

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HARLAN, R

ART UNIT

PAPER NUMBER

1713

DATE MAILED:

03/24/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/202,096

Applicant(s)

Haddleton

Examiner

Robert D. Harlan

Group Art Unit

1713



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-16, 19, and 20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-4, 6-11, 13-16, 19, and 20 is/are rejected.

☒ Claim(s) 5 and 12 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5,6

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### **DETAILED ACTION**

1. The Examiner has canceled claims 17 and 18.

#### ***Specification***

2. A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because the specification as submitted is very difficult to read and will create problems for the typesetter if the a patent is issued.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

#### ***Drawings***

3. The drawings filed on February 1, 1999 are objected to by the Draftsperson. See PTO-948 (attached to Office Action).

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*Specification*

4. The following must be corrected: on page 8, lines 2 and 3, "oH, CoOH . . . CoX;" on page 19, line 18, "at at;" on page 20, line 11, "ca.0-100%."

*Claim Objections*

5. The claims are objected to because of the following informalities: throughout the Claims section please replace "where" with --wherein--. In U.S. patent practice, when further defining an element in a claim, the term --wherein-- is preferred for a proper Markush format. See MPEP 2173.05(h) Appropriate correction is required.
6. In claim 16, line 16 please replace "R4" with --R<sub>4</sub>--.
7. In claim 11, lines 9-10 please remove the parentheses encapsulating "where p is. . . I or Cl."
8. Claim 12 is objected to because it includes a reference characters "b" which are not enclosed within parentheses. Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid

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confusion with other numbers or characters which may appear in the claims. See MPEP  
§ 608.01(m).

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1, 3-11, 13-16 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claims 1, 3 and 5 are rejected because “an organodiimine” is not defined or mentioned in the specification to describe component (c). Therefore, the claims are indefinite.

12. Claims 3, 4, 6, 7, 8, 9, 10 and 16 are rejected because the claims are written in improper Markush format. For example, in claim 3, the Markush format used by the Applicant “wherein the organodiimine is selected from: . . .” should be replace with the following language --wherein the organodiimine is selected from the group consisting of . . .--. See MPEP 2173.05(h).

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13. Claim 11 contains a double inclusion of the element "Br." "X" cannot be both "Br" and "preferably Br," for this is indefinite language. See MPEP 2173.05(o)

14. Claims 13-16 and 19-20 are held to be indefinite because they merely recite a use without any active steps. See MPEP 2173.05(q)

*Claim Rejections - 35 USC § 101*

15. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

16. Claims 13-16 and 19-20 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a asserted utility or a well established utility. The claimed invention is directed to non-statutory subject matter. Use claims are held as improper definitions of process claims. See MPEP 2173.05(q)

*Claim Rejections - 35 USC § 102*

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. Claims 1-4, 6-11, 13-16 and 19-20 rejected under 35 U.S.C. 102(b) as anticipated by Haddleton et al. ("Identifying the Nature of the Active Species in the Polymerization of Methacrylates" *Macromolecules* 1997, **30**, 3992-3998, published: July 14, 1994 hereinafter "Haddleton"). Haddleton discloses a catalysts for addition polymerization of methacrylates comprising copper (I) bromide, 2-pyridine-cabaldehyde n-propylimine and ethyl 2-bromoisobutyrate. See Haddleton, page 3995, Atom Transfer Radical Polymerization paragraph; page 3997, Atom Transfer Radical Polymerization paragraph. The catalysts is used to polymerize methacrylate in an oil bate at 90° C for 50 minutes. See id. The catalysts and process for using the catalysts in addition polymerizations as disclosed by Haddleton appears to be substantially similar to that of claims 1-4, 6-11, 13-16 and 19-20. Therefore, there is a reasonable basis to render claims 1-4, 6-11, 13-16 and 19-20 anticipated by Haddleton.

***Allowable Subject Matter***

19. Claim 5 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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20. Haddleton does not teach the use of an organodiimine comprising a chiral center or the use of 2-hydroxyethyl-2-bromopropionate as an initiator. As of the date of this Office Action, the Examiner has not located or identified prior art that could be used in combination with Haddleton to render claims 5 and 12 obvious to a person of ordinary skill in art.

*Conclusion*

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert D. Harlan whose telephone number is (703)306-5926. The examiner can normally be reached on weekdays from 9 am to 6 pm.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)306-3429.

R. Harlan  
March 21, 2000

  
DAVID W. WU  
SUPERVISORY PATENT EXAMINER  
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